

Remarks

Claims 1 and 57-60 are pending. Claims 1 and 57 has been amended. Claims 58-59 have been canceled. Claim 61 has been added.

Priority

The priority claim in the present application was objected to on the bases of:

(1) the priority claim is not in the first sentence of the application as required by 37 CFR 1.78(a)(2);

(2) the priority claim is improper for reciting that priority Application No. 09/178,170 claims benefit to the later-filed provisional application 60/179,214; and

(3) priority Application No. 09/770,534 fails to disclose that a claim for priority was ever made to provisional Application No. 60/179,214.

Regarding the first basis, Applicants note that the Amendment filed on February 12, 2007 with the Petition Under 37 CFR 1.78(a)(3) directed that the priority claim be moved to the first sentence of the application. In view of this, it is not clear to Applicants why the Office Action continues to object to the location of the priority claim. Further, Applicants understand the Examiner to be requesting, should this amendment not have been entered (which it was), to make the amendment. Applicants rely on their understanding that the amendment has been made per the Examiner's request to make said amendment. Accordingly, Applicants request that this basis of objection to the priority claim be withdrawn.

Regarding the second basis of objection (the priority claim is improper for reciting that priority Application No. 09/178,170 claims benefit to the later-filed provisional application 60/179,214), with this Response, Applicants are amending the priority claim to delete any benefit claim to provisional Application No. 60/179,214. Deletion of a benefit claim is authorized in MPEP § 201.11(III)(G). Because deletion of a benefit claim is not a claim for

benefit, the present amendment is not a late claim for benefit. Because of this, deletion of a benefit claim does not require a petition under 37 CFR 1.78(a).

Deletion of the benefit claim to provisional Application No. 60/179,214 also makes moot the third basis of objection (priority Application No. 09/770,534 fails to disclose that a claim for priority was ever made to provisional Application No. 60/179,214) because there is no need for Application No. 09/770,534 to make a benefit claim to provisional Application No. 60/179,214 because the present application no longer purports to make a claim o the ‘214 provisional application. Applicants note that the ‘534 application and the ‘170 applications were copending.

Lastly, Applicants point out that their review and understanding of the Examiner’s statements regarding the priority claim in the Office Action of October 5, 2007, as well as the prosecution history have led to the following understanding. On April 9, 2004 the day the present application was filed, a preliminary amendment was filed. Thus, as of that day, the information contained within the preliminary amendment was considered part of the application as filed. Furthermore, per the requirements of 35 USC § 120, a specific reference was made to each application within the present amended claim to priority. This, understanding is supported by the PTO’s issuance of a corrected filing receipt based on the correction of the obvious error of duplicate application numbers in the priority chain¹ which evidences the PTO’s understanding to same. Thus, the totality of the circumstances and the current understanding of the Applicants leads Applicants to have a good faith belief that the Examiner may now properly grant the requested claim to priority. Thus, there remains no basis for objecting to the priority claim. Accordingly, Applicants request that the objection to the priority claim be withdrawn and that the priority claim be accepted.

¹ The first recitation of 09/178,170 clearly is understood as an obvious error because the date is correct and it is recited as a continuation application of 09/178,170. There is only one application having these characteristics easily identifiable in the patent office.

Rejection Under 35 U.S.C. § 112, first paragraph

Claims 1 and 57-60 were rejected under 35 U.S.C. § 112, first paragraph, as not being enabled. Applicants respectfully traverse this rejection to the extent that it is applied to the claims as amended.

Claims 1 and 57-60 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention. Applicants respectfully traverse this rejection to the extent that it is applied to the claims as amended.

To begin, Applicants amended claim 1 by limiting claim 1 to “subjects, wherein the subjects are human”, and wherein the subject “wherein the subject is in need of a diagnosis of a disease, wherein the disease is Alzheimer's disease.” Applicants make this limitation merely to facilitate the prosecution of this application. The Examiner's rejection focuses on the breadth of the previous claims with respect to what the subject is and with respect to the diagnosis of any diseases. As pointed out by the Examiner, the application provides sufficient enablement for Alzheimer's disease in humans. (See for example, Page 7, lines 9-11, Applicants earnestly solicit allowance of the present claims. Should the Examiner determine that the rejection or a new rejection stand Applicants reserve the right to fully address each issue brought up in the present office action. Applicants have refrained from doing this for clarity sake as the amendments believed to address the Examiner's issues have been made. The rejection has been traversed, and the claims are in condition for allowance. Reconsideration and allowance are earnestly requested.

OBJECTION

Claims 1 and 57 were objected to for reciting I-ACT rather than α1-ACT. Claims 1 and 57 have been amended to correctly recite α1-ACT. This amendment moots the objection and the claims are believed to be in condition for allowance.

CONCLUSION

Pursuant to the above amendments and remarks, reconsideration and allowance of the pending application is believed to be warranted. The Examiner is invited and encouraged to directly contact the undersigned if such contact may enhance the efficient prosecution of this application to issue.

A deposit order account charge made electronically, representing \$1175.00 for the fee for a small entity under 37 C.F.R. § 1.17(a)(5) was made along with a Petition for Extension of Time under 37 C.F.R. § 1.136(a). This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4667.

Respectfully submitted,

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